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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,248	02/03/2004	Frank J. Cronin	Cronin-1	2588

7590

12/13/2004

Donald N. Halgren  
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Manchester, MA 01944

EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,248

Applicant(s)

CRONIN, FRANK J.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Specification***

1. The use of the trademark "Whiffle ball" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Objections***

2. Claims 15-18 are objected to because of the following informalities: in claim 15, the language "hook and loop" is unclear as the covering appears to have either the hook surface or loop surface and not both as the claim language appears to claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 14 and 17 contain the trademark/trade name "Whiffle ball". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product.

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A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the ball and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 5, 6, 9-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang (5,344,155). Regarding claim 1, Huang discloses a sports ball construction comprising first and second wrap sections (19b) that are in figure 8 configurations. Note Figures 7-9 showing the wraps covering the ball (11).

Regarding claims 5 and 6, note Figures 8 and 9 showing a pinched waist mid-portion.

Regarding claim 9, note Figures 7 and 8 showing the wraps adjacent one another.

Regarding claim 10, note column 2, lines 30-33 stating that differently sized balls may be simulated. Thus, Huang inherently provides a kit having wraps of different sizes.

Regarding claims 11 and 12, Huang provides a flexible mat (2) to function as a target backing. The flexible mat includes loop fibers.

Regarding claims 15 and 16, note the rejections of claims 10-12.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,344,155). Regarding claim 2, it would have been obvious to one of ordinary skill in the art to replace the hook elements on the ball of Huang with loop elements as such replacement is a mere reversal of parts and their associated functions.

Regarding claim 3, Huang provides a layer of adhesive (14).

Regarding claim 4, the examiner takes Official Notice that it is well known in the art to provide adhesive backings with a removable protective film in order to prevent unwanted or premature adhesion of the member. It would have been obvious to one of ordinary skill in the art to provide the adhesive layer with a protective film in order to prevent premature adhesion of the wrap.

Regarding claims 13 and 18, note column 1, lines 59-61 of Huang teaches a core of plastic material. It would have been obvious to one of ordinary skill in the art to form the core from polyethylene material in order to take advantage of that material's well known physical characteristics.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,344,155) in view of Jones-Hinton (4,151,029). Jones-Hinton discloses that it is well known in the art of tennis balls to provide covers that are in figure 8 shapes (Figure 1) or cloverleaf shapes (Figure 2). It would have been obvious to one of ordinary skill in the art to form the cover for

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the ball of Huang in the shape of a cloverleaf in order to provide an alternative shape for the cover that also accomplishes the purpose of entirely covering the ball.

11. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,344,155) in view of Lapsker et al. (5,549,302). Lapsker discloses a ball construction that is considered to be a "Whiffle" ball (Figure 3). The ball is covered with hook fastening material (22) for adhering the ball to a target. Lapsker states that the hollow ball and symmetrically placed holes provide a lightweight ball that remains attached to the target. It would have been obvious to one of ordinary skill in the art to provide the ball of Huang with a hollow inner core with symmetrically placed holes in order to have the ball remain on the target after impact therewith.

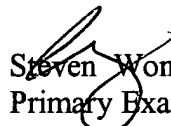
### *Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
December 9, 2004